

REMARKS

Claims 14 to 19 and 26 to 31 are canceled without prejudice, and therefore claims 12, 13, 20 to 25, and 32 to 35 are pending in the present application.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 12 to 35 were rejected under 35 U.S.C. § 102(b) as anticipated by PCT Pub. No. WO/2001/0044639 (“Matischuk”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As regards claim 12 and 24, while the rejections may not be agreed with, to facilitate matters, claims 12 and 24 have been rewritten to include the feature in which *in the at least one operating state of the drive unit, the at least one output variable of the drive unit is specified by approximating an actual value for the operating variable to the setpoint for the operating variable without consideration of the setpoint for the at least one output variable.*

The Final Office Action refers to various portions of Matischuk (e.g., page 4, lines 15 to 20 and page 6, lines 10 to 25) as assertedly disclosing features of claims 12 and 24. In fact, however, the cited portions of Matischuk merely concern setting an output variable (torques) according to an output variable setpoint (torque setpoint), while “taking into consideration the current operating state of the drive unit”, and they therefore do not identically disclose the feature in which *in the at least one operating state of the drive unit, the at least one output variable of the drive unit is specified by approximating an actual value for the operating variable to the setpoint for the operating variable without consideration of the setpoint for the at least one output variable*, as provided for in the context of claims 12 and 24, as presented.

Indeed, the output variable (torque) is always the primary object of Matischuk as it plainly states that: “If it is not possible to implement the torque change via one path alone, then a combination of control paths is selected, which *ensures that the setpoint torque is reached* within the predetermined correction time.” (Col. 4, ll. 32 to 36 (emphasis added)).

Therefore, Matischuck does not identically disclose (or even suggest) all of the features as provided for in the context of claims 12 and 24, or any of their respective dependent claims.

As further regards claims 12 and 24, claims 12 and 24 have also been rewritten to include the subject matter as provided for in the context of claims 14, 16, and 18. Thus, claims 12 and 24 as rewritten further provide that *the at least one output variable is one of a torque and a power of the drive unit, the operating variable is a speed of an engine of the drive unit, and the at least one operating state is a start-up operating state of the drive unit.* The Matischuck reference does not identically disclose (or suggest) these additional features. Therefore, claims 12 and 24, and their respective dependent claims, are allowable for these additional reasons.

As regards claims 13 and 25, while the rejections may not be agreed with, to facilitate matters, claims 13 and 25 have been rewritten to include the features in which *during the at least one operating state of the drive unit, a transformation of the at least one operating state of the drive has a priority over a transformation of the at least one output variable.*

As explained above as to claims 12 and 24, the cited portions of Matischuk merely concern setting an output variable (torques) according to an output variable setpoint (torque setpoint), while “taking into consideration the current operating state of the drive unit”, and they therefore do not identically disclose (or suggest) the features in which during the at least one operating state of the drive unit, a transformation of the at least one operating state of the drive has a priority over a transformation of the at least one output variable, as provided for in the context of claims 13 and 25, as presented.

Indeed, if anything, Matischuk places higher priority on the output variable (torque), since it plainly states that its system *ensures that the setpoint torque is reached* within the predetermined correction time. (Col. 4, ll. 32 to 36 (emphasis added)). Therefore, Matischuk does not identically disclose (or suggest) all of the features as provided for in the context of claims 13 and 25, or any of their respective dependent claims.

As further regards claims 13 and 25, claims 13 and 25 have been rewritten to include the subject matter as provided for in the context of claims 15, 17, and 19. Thus, claims 13 and 25 as rewritten provides that the at least one output variable is one of a torque and a power of the drive unit, the operating variable is a speed of an engine of the drive unit, and the at least one operating state is a start-up operating state of the drive unit. The Matischuk reference does not identically disclose (or suggest) these additional features.

Therefore, claims 13 and 25, and their respective dependent claims, are allowable for these additional reasons.

Accordingly, all of claims 12, 13, 20 to 25, and 32 to 35 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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